

IV. Determination of a Class for Original Classification or Assignment for Examination

When the content of each claim has been analyzed, it may be found that the patent or application includes two or more claims that are drawn to diverse subject matter (i.e., they are classifiable in different classes).

For search and retrieval purposes, merely placing the document in each class would suffice. However, for both administrative and legal purposes within the USPTO (e.g., ensuring the examination of patent applications by the best qualified examiner on the subject matter, restricting patent applications to properly related inventions, interference or infringement searches, etc.), there is a need to designate for U.S. patents a primary, or Original, classification. All other classifications are designated as cross-references, and the corresponding patent documents are so labeled or stamped at the top of the cover page. The following selections relate to the basis on which the "original" class is chosen or how applications having multiple claimed inventions are assigned.

A. Original Placement Between Classes

The process for selecting the claimed invention that will control original classification or assignment designation is effected by considering in turn the factors listed below:

- Selection of the most comprehensive claim;
- Selection among categories of subject matter when claims are of *equal* comprehensiveness, or when the most comprehensive claim cannot be determined;
- Selection among superiority of types of subject matter;
- Selection among generic classes and species classes thereunder; and
- Selection among classes in "related subject" listing.

1. Selection of the Most Comprehensive Claim

The claimed disclosure setting forth the most comprehensive organization (for example, a claim to a combination as compared to a claim to a subcombination or element of that combination) will control placement of a patent or application among classes. This is illustrated by comparing the following two claims (which not only differ in comprehensiveness, but also are directed to different categories of subject matter) each of which define subject matter properly classified in a different class:

Claim 1

A laminated sheet comprising two panels of aluminum bonded with an intermediate layer of a binder, said binder comprising an elastic, self-vulcanizing rubber-like

cement, the adjacent faces of the panels being roughened in a cross-hatched pattern to facilitate adhesion of the cement, two opposite edges of the sheet being notched with corresponding, interfitting dovetail cutout portions to facilitate securing the edges one to the other.

Claim 2

A process comprising scoring the faces of two aluminum panels in a cross-hatched pattern, applying a binder to the scored faces, pressing the coated faces together to secure the panels and forming a sandwich and then bending the sandwich and securing the opposite edges to each other to form a tube.

Explanation

Claim 1 encompasses a product comprising a laminated sheet. Claim 2 encompasses a process of making such a sheet, but includes the additional steps of bending the sheet and securing the edges to form a tube. Process Claim 2 thus contains a greater extent of subject matter than does Claim 1 and is therefore more comprehensive. Assuming that separate classes provided for the subject matter in Claim 1 and 2, respectively, a patent with these two claims should be placed as an original in the class providing for the subject matter of Claim 2.

Please note that mere details of a subcombination, as a rule, do not generally increase the comprehensiveness of a claim. Thus, Claim 1 above would not become more comprehensive than Claim 2 if Claim 1 were amended merely to recite the details of the nature of the binder composition.

2. Selection Among Categories of Subject Matter

When a patent includes separate claims to two or more different categories of subject matter and none of the claims is more comprehensive than the other(s) or if greater comprehensiveness cannot be determined, the Original is placed in the class providing for the claimed category that appears highest in the following list:

1. Process (of using product 2, e.g., using a fuel or radio transmitter)
2. Product (of manufacture, e.g., a fuel or radio transmitter)
3. Process (of making product 2)
4. Apparatus (to perform 3 or to make 2, e.g., machine, tool, etc.)
5. Materials (used in 3 to make 2)

For example, when considering claims to a radio transmitter (category 2) and to a process of manufacturing the same (category 3), the claim to the transmitter would control class assignment. Similarly, a claim to a process of using the transmitter (category 1) would control over a claim to the transmitter or process of making it.

Modern patent classification schedules often separate categories of related subject matter into different classes or, if several categories are included in the same class, put them in different groups of subclasses. In the latter case, the priority given above is frequently used to determine order of subclass groupings. For situations where all claims are provided for in the same class, see Section V, B, below, to determine placement in the proper subclass.